



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/839,161	04/22/1997	WILLIAM P. NEWTON		9755

20808 7590 03/01/2005

BROWN & MICHAELS, PC
400 M & T BANK BUILDING
118 NORTH TIOGA ST
ITHACA, NY 14850

EXAMINER

STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
----------	--------------

3634

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/839,161

Applicant(s)

NEWTON ET AL.

Examiner

Gregory J. Strimbu

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) 26-38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11, 53, 54 and 58-60 is/are allowed.
- 6) ☒ Claim(s) 12-52 and 55-57 and 61-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 2/14/05.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

It should first be noted that the Office action of July 9, 2004 was recorded as a final rejection. After reviewing the history of the application, it has been determined that the Office action of July 9, 2004 should not have been recorded as a final rejection. Accordingly, the applicant's response of September 2, 2004 has been entered as a matter of right and the following Office action has been prepared in response to the applicant's amendment of September 2, 2004.

Claim Rejections - 35 USC § 112

Claims 14, 19-23, 39-52, 55-57, 61-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "rest position" on line 3 of claim 14 render the claims indefinite because it is unclear if the rest position is a position of the support arms or the shoes. Recitations such as "shoe" on line 2 of claim 19 render the claims indefinite because it is unclear to which of the plurality of shoes set forth above the applicant is referring. Recitations such as "a guide that slides in each respective one of the jambs" on lines 2-3 of claim 19 render the claims indefinite because it is unclear how one guide can be disposed in both jambs. Recitations such as "the jamb channels" on line 3 of claim 22 render the claims indefinite because they lack antecedent basis. Recitations such as "outwardly extend" on line 9 of claim 39 render the claims indefinite because it is unclear with respect to what element of the invention the support arm the sash support arm is outwardly extended. Recitations such as "the platform" on lines 2-3 of

Art Unit: 3634

claim 40 and "the shoe profile" on line 1 of claim 41 render the claims indefinite because they lack antecedent basis. Recitations such as "engaging end regions" on line 3 of claim 55 render the claims indefinite because it is unclear if the counterbalance regions or the support regions engage the end regions. Recitations such as "a sash" on lines 6-7 of claim 61 render the claims indefinite because it is unclear if the applicant is referring to the sash set forth above or is attempting to set forth another sash in addition to the one set forth above. Recitations such as "support arm secured to each of two stiles of the sash" on lines 6-7 of claim 67 render the claims indefinite because it is unclear how one support arm can be secured to both stiles of the sash at the same time. Recitations such as "lifting regions" on line 5 of claim 74 render the claims indefinite because it is unclear what element of the invention includes the lifting regions.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 61 is rejected under 35 U.S.C. 102(b) as being anticipated by Johnson '511. Johnson '511 discloses a system locking counterbalance shoes (not specifically numbered, but shown in figure 4) to window jambs 1 while a sash 6 supported on the shoes is removed from between the window jambs, the system comprising: the shoes having hooks 19 that are pivotally mounted on the shoes below sash supporting

Art Unit: 3634

platforms 16 of the shoes so that the hooks can move between latched and unlatched positions while a sash 6 is supported on the platforms; the hooks in unlatched positions hanging dependently downward from the shoes below the sash supporting platforms where the hooks are disposed to hook under lances 21 formed in the jambs as the shoes rise; and the hooks in latched positions being retained out of engagement with the jambs and clear of the lances.

Claims 74-85 are rejected under 35 U.S.C. 102(b) as being anticipated by Osten. Osten discloses a system counterbalancing a laterally removable sash 20 supported by counterbalanced sash shoes 92 respectively running vertically in opposed jambs arranged along opposite stiles of the sash, the system comprising support arms 50 pivotally mounted on the sash to extend between the sash and sash shoes 92 that are biased upward at lifting regions spaced from each sash stile, the support arms being arranged for transferring the weight of the sash to the shoes at support regions (not numbered, but shown in figure 1) of the shoes that are arranged vertically below the lifting regions to minimize any moment arms tending to turn the shoes around horizontal axes, and the support arms moving to downwardly hanging positions in response to movement of the sash upward to lift the support arms above the shoe support regions and outwardly from the jambs, the shoes 92 are formed of metal (claim 76), the support arms 50 are formed of metal (claim 77).

Claims 86-90 are rejected under 35 U.S.C. 102(b) as being anticipated by Osten. Osten discloses a system supporting a sash 20 that is laterally removable from between opposed window jambs, the system including counterbalance shoes 92 arranged within the jambs to be spaced laterally from stile edges of the sash to allow lateral movement of the sash for removing the sash from between the jambs, and the system comprising: sash support arms 50 bridging distances between the shoes and stiles of the sash, the support arms being movable between sash supporting positions (as shown in figure 1) in which the support arms transfer weight of the sash to the shoes and sash uplifted positions (not shown, but the position when the arms are pivoted towards the sash so that the sash can be removed from the jambs) in which the support arms hang downward from the sash stiles and allow lateral movement of the sash between the shoes; counterbalance lifting regions 82 for the shoes being arranged vertically above support regions (not numbered, but shown in figure 1) of the shoes that uphold the weight of the sash transferred via the support arms to the shoes to minimize any moment arms tending to turn the sash shoes around horizontal axes; and the sash support arms in the support positions being braced against moving in response to sash weight.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3634

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-15, 19 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osten in view of Haas '630. Osten discloses a system counterbalancing a window sash 20 supported by a pair of counterbalanced sash shoes 84, 92 so that the sash extends between a pair of jambs 12 from which the sash is removable by maneuvering the sash upward and laterally while the shoes are locked in the jambs, the improvement comprising: the shoes having a predetermined profile (not numbered, but comprising the profile of 84) extending for a width of each of the shoes and establishing a configuration of each of the shoes; and the configuration extending in a single piece of the predetermined extrusion profile from a hook-shaped upper region 82 formed to interconnect with a counterbalance element 78 to an L-shaped lower region 92 forming a platform (not numbered, but shown in figure 1) extending toward the sash from vertically below the upper region, sash support arms 50 (claim 13), the shoes include metal locking elements 98 (claim 16), a guide 110 (claim 19). Osten is silent concerning the predetermined profile comprising a metal.

However, Haas '630 discloses a sash shoe 64 comprising a metal.

It would have been obvious to one of ordinary skill in the art to provide the predetermined profile of Osten with a metal construction, as taught by Haas '630, to increase the strength of the sash shoes.

Art Unit: 3634

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osten in view of Haas '630 as applied to claims 12-15, 19 and 22-25 above, and further in view of Westfall '795. Westfall '795 discloses jamb projections 60.

It would have been obvious to one of ordinary skill in the art to provide Osten, with jamb projections, as taught by Westfall '795, to more securely hold the shoes in a locked position.

Claims 12, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas '630 in view of Osten. Haas '630 discloses a system counterbalancing a window sash 24 supported by a pair of counterbalanced sash shoes 64 so that the sash extends between a pair of jambs 16, 18, 20 from which the sash is removable by maneuvering the sash upward and laterally while the shoes are locked in the jambs, the improvement comprising: the shoes having a predetermined profile (not numbered, but comprising the profile of 64) extending for a width of each of the shoes and establishing a configuration of each of the shoes; and the configuration extending in a single piece of the predetermined extrusion profile from an upper region (not numbered, but shown in figure 2) formed to interconnect with a counterbalance element 58 to an L-shaped lower region 65 forming a platform (not numbered, but shown in figure 2) extending toward the sash from vertically below the upper region, a mid region of the shoe (not numbered, but shown in figure 2) includes a guide retaining groove 74 for receiving a guide 82.

Osten discloses a sash shoe 84, 92 having a hook shaped upper region (not numbered, but shown in figure 1) for connecting to a counterbalance element 78.

It would have been obvious to one of ordinary skill in the art to provide Haas '630 with a hook shaped upper region, as taught by Osten, to increase the ease with which the sash shoe can be connected to the counterbalance element.

Claims 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson '511 as applied to claim 61 above, and further in view of Haas '630. Haas '630 discloses a metal sash counter balance shoe 64 and a metal hook 92, the shoe 64 including guiding means 82 for guiding movement of the shoe within the jamb.

It would have been obvious to one of ordinary skill in the art to provide Johnson '511 with a metal construction, as taught by Haas '630, to increase the strength of the shoe.

Allowable Subject Matter

Claims 1-11, 53, 54 and 58-60 are allowed.

Claims 18, 21, 39-52, 55-57, 62, 63 and 66-73 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, if any, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach the combination of a sash, opposed window jambs, and a pair of sash support

Art Unit: 3634

arms mounting to hang freely downward on respective opposite sides of the sash. See claim 1, line 4.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach the combination of a window sash, a pair of counterbalanced shoes wherein the locking elements formed as hooks that catch on the jamb projections and the shoes have latches that latch the locking elements in undeployed positions out of engagement with the window jambs. See claim 18, lines 1-4.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach the combination of a window sash, a pair of counterbalanced shoes wherein the profile having a latch retaining groove and a pin groove for receiving a pivot pin of the shoe hook. See lines 1-3 of claim 21.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach the sash support arm dropping to a downwardly dependent position when the sash support arm does not engage the platform shaped lower region. See lines 7-11 of claim 39.

Art Unit: 3634

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach a resilient latch mounted on the shoe for retaining the shoe in the undeployed position. See lines 1-2 of claim 42.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach sash support arms movably mounted respectively on each stile of a sash so that the support arms hang downward in dependent positions when not supporting the sash and move outward to braced positions in response to engagement of the support arms with locked sash shoes as the sash is lowered between the shoes so that the weight of the lowered sash urges the sash support arms outward on the shoes to the braced positions. See lines 2-9 of claim 53.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach resilient latches carried on the shoes for holding the hooks in the latched positions. See lines 1-2 of claim 62 and lines 1-3 of claim 66.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior

Art Unit: 3634

art of record fails to teach the sash having a support arm secured to each sash stile so that the sash support arms hang downward in positions in which lower ends of the support arm engages sash end regions of the shoe platforms when the sash and the support arms are moved downward from above the shoe platforms, the sash support arms being mounted on the sash to pivot between the downwardly hanging position and outwardly extending positions as weight of the downwardly moved sash transfers to the shoes via the support arms. See lines 8-19 of claim 67.

Response to Arguments

Applicant's arguments filed September 2, 2004 have been fully considered but they are not persuasive.

The applicant's comments concerning claim 39 are moot in view of the indication of allowable subject matter recited in claim 39.

With respect to the applicant's comments concerning Osten and claims 74-85, the examiner respectfully disagrees. As shown in figure 3 of Osten, the position the sash support arm engages the support platform of element 92 is positioned in the center of element 92. Therefore, the moment arm tending to rotate the shoe left or right, as shown in figure 3, is minimized. Additionally, when the sash 20 of Osten is removed from the window frame 12, the support arms 50 must be moved inwardly with respect to the sash, therefore the support arms are dropped to a downwardly dependent position when the sash support arms do not engage the platform shaped lower region.

With respect to the applicant comments concerning Osten and claim 12, the examiner respectfully disagrees. It should first be noted that claim 12 only requires that the predetermined extrusion profile comprise a single piece. As set forth in the rejection above, Osten discloses a predetermined profile 84 comprising a single piece and which extends from a hooked shaped upper region 82 to a L-shaped lower region. The L-shaped lower region being formed by the predetermined profile and element 92.

The applicant's comments concerning claim 16 are not persuasive because they are not supported by the claim language. No recitation in claim 16 requires that the locking elements be separate.

The applicant's comments concerning claims 17, 61, 64, 65 are moot in view of the new grounds of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. The applicant has at least amended claim 12 to include the new limitation of a single piece; claim 61 to include the new limitation of while a sash is supported on the platforms; and claim 86 to remove the limitation of the sash weight does not subject the sash shoes to moment arms.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

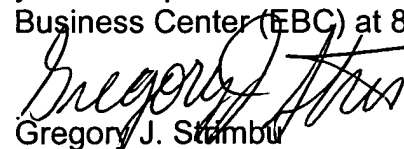
Art Unit: 3634

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory J. Strimbu
Primary Examiner
Art Unit 3634
February 17, 2005